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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,970	02/01/2002	J. Bryan Jones	23623-7076	4739

7590

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EXAMINER

RAO, MANJUNATH N

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/062,970

Applicant(s)

JONES ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-42 are pending in this application.

***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, drawn to a chemically modified mutant protein, classified in class 530, subclass 408.
  - II. Claims 11-20, drawn to a method of producing a chemically modified mutant protein, classified in class 435, subclass 440.
  - III. Claim 21, drawn to a glycosylated thiosulfonate, classified in class 532, subclass 29.13.
  - IV. Claims 22-26, drawn to a method of modifying functional characteristics of a protein, classified in class 435, subclass 440.
  - V. Claims 27-42, drawn to a method for determining structure function relationship, classified in class 435, subclass 4.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case mutant enzyme can be made by using recombinant techniques as opposed to chemical modification.
5. Inventions I and III are patentably distinct from each other. The polypeptide of group I, the glycosylated thiosulfonate of group III, each comprise chemically unrelated molecules, do not require each other for practice; have separate utilities, such as use of the group I polypeptide to catalyze a proteolytic reaction versus the use of glycosylated thiosulfonate as a chemical

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agent and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

6. Inventions I and IV or V are patentably distinct from each other. The polypeptide of group I, the methods of group IV and V do not require each other for practice; have separate utilities, such as use of the group I polypeptide to catalyze a proteolytic reaction versus the methods of group IV and V to modify the characteristics of a protein and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

7. Inventions II, IV or V and III are patentably distinct from each other. The glycosylated thiosulfate of group III, the methods of groups II, IV and V do not require each other for practice; have separate utilities, such as use of the group III glycosylated thiosulfate as chemical reagent versus the methods of groups II, IV and V to modify the characteristics of a protein and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

8. Inventions II, IV and V are patentably distinct from each other. The method of producing a chemically modified mutant protein of group II, the method of modifying functional characteristics of a protein of group IV and the method of determining structure function relationship of group V are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

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9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The Examiner can normally be reached on M-F from 6:30 a.m. to 3:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, P.Achutamurthy, can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



MANJUNATH N. RAO  
PATENT EXAMINER

Manjunath N. Rao

7/3/03